

Remarks

I. Status of the Claims

Claims 1-65 are pending in this application. No claims have been amended.

II. Rejection under 35 U.S.C. § 103

de la Mettrie '295 and Research Disclosure

Claims 1-6 and 8-65 are rejected under § 103(a) as being unpatentable over U.S. Patent No. 5,989,295 ("de la Mettrie '295") in view of Research Disclosure, December 1999, pp. 1552-1554 (XP-000934522, "Research Disclosure"). *Office Action* at pp. 2-3. Applicants respectfully traverse this rejection.

Each of independent claims 1, 22, 42, and 64 recite at least one anionic associative polymer comprising at least one carboxylic acid group and at least one ester derived from a fatty alcohol and a carboxylic acid, and at least one additional anionic associative polymer comprising at least one carboxylic acid group and at least one ester derived from an alkoxylated fatty alcohol and a carboxylic acid. The Examiner rejects the claims because de la Mettrie '295 teaches a hair dyeing composition comprising "at least one anionic polymer." *Id.* at p. 3. The Research Disclosure is cited for teaching that "polymers in the dyeing composition prevent the composition from running out of the hair and make the composition [maintain] its gelled nature," *i.e.*, Acrylate/Steareth-20 Methacrylate Copolymers or Acrylates/Methacrylates/Beheneth-25 Methacrylate Copolymers. *Id.* The Examiner supports the combination of references because both references are in the "analogous art of cosmetic formulation ... one of ordinary skill in the art [would] be

motivated to use the polymers [of Research Disclosure] in the hair dyeing composition of [de la Mettrie '295]. *Id.*

Applicants respectfully submit that merely identifying each of the claimed elements in the prior art is not sufficient to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the Examiner must show a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. See M.P.E.P. § 2143. Another element required to establish a *prima facie* case of obviousness is that the cited references must teach or suggest all the claim limitations. M.P.E.P. § 2143.

Applicants respectfully submit that the cited references offer no such suggestion. According to de la Mettrie '295, oxidation dye compositions have traditionally been localized, *i.e.*, "in order for it not to run down the face," by using traditional thickeners. *de la Mettrie* '295 at col. 1, lines 36-44. *de la Mettrie* '295 observes, however, that traditional thickeners can "impede the rise of the dye on the fibres, which is reflected in a dull shade." *Id.* at col. 1, lines 45-51. If such traditional thickeners were used, more dye would be required to obtain an intense shade, along with greater amounts of solvents and/or surfactants to dissolve the dye. *Id.* The discovery of de la Mettrie '295 relates to the use of an anionic amphiphilic polymer containing at least one hydrophilic unit and at least one hydrophobic unit comprising a C₁₀-C₃₀ alkyl ester of unsaturated carboxylic acid. *Id.* at col. 1, line 58 to col. 2, line 7. Compositions containing this polymer "do not run

... and ... also make it possible to obtain more chromatic (more luminous) and more intense shades.” *Id.*

Thus there is no motivation in de la Mettrie ‘295 to use at least one additional polymer. If anything, de la Mettrie teaches one of ordinary skill in the art to avoid the use of traditional thickeners because these can be detrimental to the resulting dye color. Although Applicants do not characterize the Acrylate/Steareth-20 Methacrylate Copolymers or Acrylates/Beheneth-25 Methacrylate Copolymers of the Research Disclosure as traditional or non-traditional, one of ordinary skill in the art, however, would be cautioned against simply adding other thickeners in view of de la Mettrie’s teachings that traditional thickeners can result in an inferior coloring. Additionally, there is no motivation to add an additional thickener to the composition of de la Mettrie ‘295 since a polymer that can achieve the desired thickening is already provided.

Even more than failing to suggest an additional polymer, de la Mettrie does not suggest the claimed additional polymer, *i.e.*, comprising at least one carboxylic acid group and at least one ester derived from an alkoxylated fatty alcohol and a carboxylic acid. Evidence of a suggestion or motivation to modify or combine must be “clear and particular.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Due to the specificity of the claimed additional polymer, the Examiner must provide a clear and particular suggestion to add the polymers of the Research disclosure to de la Mettrie’s composition. This has not been done here. Instead, the rejection consists of combining elements of two separate documents to arrive at the Applicants claimed invention with no suggestion to do so.

Because neither reference specifically suggests the claimed combination, Applicants respectfully submit that a *prima facie* case has not been established. Accordingly, Applicants respectfully request withdrawal of this rejection.

de la Mettrie '295, Research Disclosure, and de la Mettrie '195

Claim 7 is rejected under § 103(a) as being unpatentable over U.S. Patent No. 5,989,295 ("de la Mettrie '295") in view of Research Disclosure, December 1999, pp. 1552-1554 (XP-000934522, "Research Disclosure"), and further in view of U.S. Patent No. 5,976,195 ("de la Mettrie '195"). *Office Action* at p. 3. Applicants respectfully traverse this rejection.

The Examiner maintains the rejection "for the same reasons stated above." *Id.* In the previous Office Action, the Examiner stated that one of ordinary skill in the art would be motivated to modify the anionic associative polymer of de la Mettrie '295 with the allyl ether of de la Mettrie '195. *Non-final Office Action* at p. 7.

Applicants respectfully submit that because there is no suggestion to combine de la Mettrie '295 and the Research disclosure, it necessarily follows that the combination of de la Mettrie '295, the Research disclosure, and de la Mettrie '195 is also improper.

Moreover, as discussed above, there is no motivation in any of the cited references to add the claimed at least one additional polymer to the formulations of de la Mettrie '295. de la Mettrie '195 does not remedy this deficiency. de la Mettrie '195, which has substantially the same background as de la Mettrie '295, describes an oxidation dye composition comprising an anionic amphiphilic polymer containing at least one hydrophilic unit and at least one allyl ether unit containing a fatty chain.

de la Mettrie '195 at col. 1, lines 8-12. The hydrophilic unit can be a vinyl carboxylic acid, such as acrylic or methacrylic acid. *Id.* at col. 3, lines 25-28. *de la Mettrie* '195 also discloses "a crosslinked terpolymer of methacrylic acid, of ethyl acrylate, and of steareth-10 allyl ether." *Id.* at col. 3, lines 62-64. There is no suggestion, however, in *de la Mettrie* '195 to add any additional polymer, much less the claimed additional polymer. Like *de la Mettrie* '295, *de la Mettrie* '195 criticizes the use of traditional thickeners to in that they can "decrease the uptake of the dye on the fibers." *Id.* at col. 1, lines 41-43. Thus, not only does *de la Mettrie* '195 fail to suggest at least one additional polymer, one of ordinary skill in the art would be dissuaded from adding traditional thickeners in light of the teachings of *de la Mettrie* '195.

Accordingly Applicants respectfully request withdrawal of this rejection.

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III. Conclusion

Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extension of time under 37 C.F.R. § 1.136 required to enter this response and charge those additional fees to our Deposit Account No. 06-916.

Respectfully submitted,

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